

REMARKS

The Action states that submitted claim 14, drawn to a plurality of functional groups, attached to the RNA, is independent or distinct from the invention as originally claimed because the originally presented invention is drawn to a single functional group attached to the RNA. Applicants respectfully disagree. The originally filed claim recites an RNA *comprising* a functional group attached to the RNA. Comprising does not limit the modified RNA to a single modification or functional group. Modification with multiple functional groups is supported in the specification on page 6 lines 20-21, page 7 lines 24-25, page 8 lines 14-15, and page 11 lines 30-34.

Rejection of the claims under 35 USC § 102:

Claims 1, 4-9, and 13 have been rejected under 35 U.S.C. 102(b) as being anticipated by Goldsborough (WO 01/94626). Applicants have amended claim 1 to obviate the rejection. Specifically, Applicants have incorporated the limitations of claim 11 into claim 1.

Claims 1, 4, 5, 10, and 12-13 have been rejected under 35 U.S.C. 102(b) as being anticipated by Monia et al. (U.S. Patent No. 6,165,789). Applicants have amended claim 1 to obviate the rejection. Specifically, Applicants have incorporated the limitations of claim 11 into claim 1.

Claims 1, 4, 10, and 12 have been rejected under 35 U.S.C. 102(e) as being anticipated by Tuschl et al. (WO 02/44321). Applicants have amended claim 1 to obviate the rejection. Specifically, Applicants have incorporated the limitations of claim 11 into claim 1.

Claims 1, 4 and 11 have been rejected under 35 U.S.C. 102(e) as being anticipated by Tuschl et al. (US 2005/0059005). Applicants respectfully disagree. The Action states that, based on the definition of labile bond in the specification, any modified RNA comprising a functional group post-synthetically linked to the RNA is linked via a labile bond. In support of this argument, the Action recites only a portion of the definition of

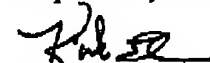
labile as given in the specification. (page 13 lines 1). However, the full definition (page 13 lines 1-6) states that, in order for the bond to be selectively broken, the bond must be able to be broken without breaking other covalent bonds in the molecule. The Action further states that the specification does not define the selective conditions that would cleave a labile bond. Applicants respectfully disagree. The specification states that the bond is labile under mammalian physiological conditions, page 2 lines 15-17, page 5 lines 21-24. Tuschl et al. do not teach, at paragraphs 0016, 0017, or elsewhere, labile or reversible bonds or attachment of functional groups to RNA such that the groups can be removed without breaking other bonds in the RNA under any conditions. Applicants request reconsideration of the 102 rejection.

Rejection of the claims under 35 USC § 103:

Claims 1-9 and 13 have been rejected under 35 U.S.C. 103(a) as being obvious over Goldsborough (WO 01/94626) in view of Monahan et al. (U.S. Patent No. 6,630,351). Applicants have amended claim 1 to obviate the rejection. Specifically, Applicants have incorporated the limitations of claim 11 into claim 1.

The Examiner's rejections are now believed to be overcome by this response to the Office Action. In view of Applicants' amendment and arguments, it is submitted that claims 1, 4-10, 12, and 13 should be allowable.

Respectfully submitted,



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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as express mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date: February 27, 2006.

  
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